

## **REMARKS**

Claims 1-15 are pending in the above-referenced patent application. No claims have been cancelled, added or amended.

### **Objection to the Drawings**

In the Office Action, dated February 25<sup>th</sup>, 2005, the Examiner objected to the Drawings, specifically, Figure 1. Assignee has provided a substitute sheet for Figure 1 to address the objection of the Examiner. It is respectfully requested that the Examiner withdraw the objection to the Drawings.

### **Claim Rejections – 35 U.S.C §103(a)**

The Examiner has rejected claims 1, 6 and 11 under 35 U.S.C 103(a) as being unpatentable over Sung (US Patent No. 6,587,231) in view of Matsumoto (US Patent No. 6,147,339); rejected claims 2,7 and 12 under 35 U.S.C 103(a) as being unpatentable over Sung in view of Matsumoto and further in view of Hu et al. (US Patent No. 6,271,939, hereinafter “Hu”); and claims 3, 5, 8, 10 13 and 15 under 35 U.S.C 103(a) as being unpatentable over Sung in view of Matsumoto and further in view of Motamed (US Patent No. 6,327,047). These rejections are respectfully traversed.

### **Sung v. Matsumoto**

Referring now to claims 1, 6 and 11, Assignee respectfully submits that these claims are not rendered obvious by the cited art, Sung in view of Matsumoto. It is noted that in order to establish *prima facie* obviousness there must be some suggestion or motivation to modify or combine reference teachings, and the combination, if successful, must teach or suggest all of the claim limitations. As stated in the Manual for Patent Examining Procedure (MPEP), § 2142/2143, “To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined)

must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." It is respectfully submitted that the cited references do not meet these criteria. For example, the prior art references, if successfully combined, would still not teach or suggest all the claim limitations.

The Examiner already concedes that Sung is lacking at least one element of the rejected claims. According to the Examiner, "Sung does not specify that the transparent material used to make the transparent housing in acrylic." Although Assignee does not necessarily agree with the Examiner's characterization of the rejected claims, it is respectfully submitted that Sung, whether viewed alone or in combination with Matsumoto, does not contain all of the elements of the rejected claims. However, Assignee does not by this argument accept that the combination is proper; rather, while Assignee asserts that the combination is improper, Assignee further asserts that even if the combination were proper, and a successful combination of Sung and Matsumoto were made, although Assignee has serious doubts concerning the ability to do so, the resultant combination or any of the other alleged combinations would still not provide one or more of the elements lacking from Sung.

It is first noted that the section Sung which the Examiner cites (col.2, lines 36-37) pertains to the transparent housing (1) and not to either of the transparent windows (2,3) which form separate parts, not integral with the housing. Accordingly, there is no disclosure or suggestion in Sung that "a document-loading panel is made of a transparent acrylic material", as recited in claim 1.

Furthermore, it is noted that the Matsumoto reference concerns a hand-held portable scanner that rolls over a document during a scanning procedure. Thus, the transparent window (18) located at the bottom of the apparatus according to Matsumoto does not constitute a document-loading panel, as the portable scanner apparatus of Matsumoto does not hold documents. It is therefore submitted that the cited references themselves provide no suggestion to apply the teaching of an acrylic window used in a roller scanner that does not hold documents to a scanner apparatus in which the transparent window does hold documents. Therefore, it is respectfully submitted that there is no suggestion to combine the cited references, and the cited references do not render claim 1 obvious. Additionally, claims 6 and 11 are not rendered obvious for at least the same reasons.

**Sung v. Matsumoto v. Hu**

The Examiner has rejected claims 2, 7 and 12 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Hu. It is respectfully submitted that Hu does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of the rejected claims. Therefore, claims 2, 7 and 12 are not rendered obvious for at least the same reasons as presented with reference to claims 1, 6 and 11, above. It is respectfully requested that the Examiner withdraw the rejection to these claims.

**Sung v. Matsumoto v. Motamed**

The Examiner has rejected claims 3, 5, 8, 10, 13 and 15 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Motamed. It is respectfully submitted that Motamed does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of the rejected claims. Therefore, claims 3, 5, 8, 10, 13 and 15 are not rendered obvious for at least the same reasons as presented with reference to claims 1, 6 and 11, above. It is respectfully requested that the Examiner withdraw the rejection to these claims.

**Sung v. Matsumoto v. Pan**

The Examiner has rejected claims 4, 9 and 14 under 35 USC 103(a) based on Sung in view of Matsumoto and further in view of Pan. It is respectfully submitted that Pan does not cure the deficiencies of Sung and Matsumoto discussed above, and does not show or describe the limitations of the rejected claims. Therefore, claims 4, 9 and 14 are not rendered obvious for at least the same reasons as presented with reference to claims 1, 6 and 11, above. It is respectfully requested that the Examiner withdraw the rejection to these claims.

Assignee respectfully submits that because a prima facie case of obviousness has not been established, claims 1-15 are in a condition for allowance. It is noted that many other bases for traversing the rejections could be provided, but Assignee believes that the grounds presented above

are sufficient. It is, therefore, respectfully requested that the Examiner withdraw the rejection of these claims.

**CONCLUSION**

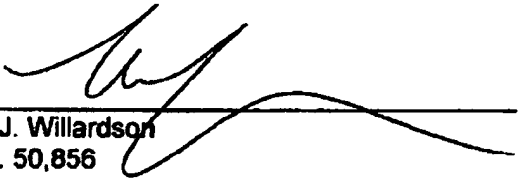
In view of the foregoing, it is respectfully submitted that all of the claims pending in this patent application are in condition for allowance. If the Examiner has any questions, she is invited to contact the undersigned at (503) 439-6500. Reconsideration of this patent application and early allowance of all the claims is respectfully requested.

Please charge any shortages and credit any overcharges of any fees required for this submission to Deposit Account number 50-3130.

Respectfully submitted,

Dated: \_\_\_\_\_

8/25/05

  
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Michael J. Willardson  
Reg. No. 50,856

Berkeley Law and Technology Group, LLC  
1700 NW 167th Place, Suite 240  
Beaverton, OR 97006